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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/117,795	11/10/1998	MITSUO SADO	CU-1758RJS	4079

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EXAMINER

GARRETT, DAWN L

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/05/2002

32

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant N .

09/117,795

Applicant(s)

SADO, MITSUO

Examiner

Dawn Garrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on November 5, 2002 has been entered.
2. The examiner notes the Reply Brief (paper no. 30) received November 13, 2002 has not been considered or entered because applicant has reopened prosecution.
3. The amendment submitted with the Request for Continued Examination has been entered. Claim 1 was amended. Claims 1-4 are pending.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-4 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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6. In claim 1, clear support for the added negative limitation "said composition being free of ethylene glycol mono-butyl ether" has not been found in the specification.

Accordingly, the added limitation is considered to be new matter.

7. Support in the specification has not been found for " $C_4H_9-O-(CH_2CH_2O)_HN$ " as recited in amended claim 1 (see also paragraph 9 below).

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. The subscript "H" in the formula of amended claim 1 is undefined. In addition, there is no "n" in the formula. Correction is required. For examination purposes, the examiner has assumed applicant intends for the organic solvent to be " $C_4H_9-O-(CH_2CH_2O)_nH$ " as recited in previous versions of claim 1 rather than " $C_4H_9-O-(CH_2CH_2O)_HN$ " as currently recited.

11. Claim 2 recites the limitation "diethylene glycol mono-n-butyl ether and triethylene glycol mono-n-butyl ether". Presently, claim 1 does not recite an ether as component (A). There is insufficient antecedent basis for the ether limitations in the claim 2.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-4 are rejected under 35 U.S.C. 103(a) as obvious over JP 63-069897 A

(see full English translation for citation references). Japanese patent 63-069897 A

describes a cleaner composition comprising 5-95 % of one or more amines of mono-,

di-, and triethanol amines, 0.2-50 % of one or more high boiling point solvents

comprising diethylene glycol monobutyl ether and benzyl alcohol used for removal of

heavy dirt attached to hard surfaces. Instant claim 1 is drawn to "A releasing agent

composition...which comprises as essential components...(A) 5 to 75% by weight of a

water-soluble organic solvent represented by the formula $C_4H_9-O-(CH_2CH_2O)_nH$ where

n is an integer of 2 or 3". Present claim 2 is drawn to a composition wherein (A) may be

diethylene glycol monobutyl ether. JP 63-069897 clearly reads on instant component

(A) by disclosing diethylene glycol monobutylether (see page 2 of translation, lines 4

and 5 of part (b)). Per the instant claim 1 requirement of 15 to 40% by weight of benzyl

alcohol, JP 63-069897 also clearly discloses benzyl alcohol as a component of the

composition (see page 2 of the translation, line 5 of (b)). Applicant recites an amine

compound in instant claim 1 and a specific amine, alkanolamine, in instant claim 3. JP

63-069897 clearly discloses alkanolamines such as monoethanol amine, diethanol

amine, and triethanol amine as part of the composition (see page 2 of translation, line 3

of part (a)). In addition to the JP 63-069897 teaching of all components recited in

instant claim 1 parts (A) – (C), the component amounts taught for the JP 63-069897

composition encompass and/or overlap with the ranges recited in instant claim 1.

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Applicant requires 10 to 20% by weight of an amine compound, component (C). JP 63-069897 teaches 5 to 95 parts of one or more amines (see page 2, lines 1 and 2 of part (a)), which clearly encompasses the required range of 10 to 20% by weight. Applicant requires 15 to 40% by weight of benzyl alcohol (component (B)) and 5 to 75% by weight of a water-soluble organic solvent represented by the formula $C_4H_9-O-(CH_2CH_2O)_nH$ where n is an integer of 2 or 3. JP 63-069897 teaches 0.2 to 50 parts of a combination of solvents including diethylene glycol monobutylether and benzyl alcohol (see page 2, lines 4 and 5 of part (b)). The JP 63-069897 teaching of 0.2 to 50 parts of a combination of diethylene glycol monobutylether and benzyl alcohol clearly encompasses and/or overlaps with the required amounts of 15 to 40% of benzyl alcohol and 5 to 75% by weight of a water-soluble organic solvent such as diethylene glycol monobutyl ether. Per instant claim 4, the working examples taught by JP 63-069897 describe diluting the cleaning compositions in water (see "Working Examples" page 7 of translation). It would have been obvious to one of ordinary skill in the art at the time of the invention to produce the claimed composition in the recited proportions of ingredients, since each of the claimed components in the claimed weight ranges are disclosed by JP 63-069897.

Examiner's Response

14. Applicant states "Applicant is now submitting this Request for Continued Examination to reopen the prosecution of the above-identified application to amend the claims to clearly exclude ethylene glycol mono-butyl ether. This amendment should place the claims 1-4 in condition for allowance." The examiner respectfully notes that

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the added negative limitation has not put the claims in condition for allowance, because the 35 USC 103(a) rejection over JP 63-069897 is respectfully maintained. JP 63-069897 does not require the composition comprise ethylene glycol mono-butyl ether, but rather recites the solvent in a Markush group as a possible solvent. The reference recites as component (b) (see second page of translation) "0.2 to 50 weights parts, and preferably 2 to 20 weight parts, of **one or more** high-boiling solvents selected from ethylene glycol monoethyl ether, diethylene glycol monoethyl ether, ethylene glycol monobutyl ether, **diethylene glycol monobutyl ether**, and **benzyl alcohol**". The teaching clearly does not require that ethylene glycol monoethyl ether be present and accordingly, applicant's added negative limitation has not overcome the teaching of JP 63-069897.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dawn Garrett whose telephone number is (703)305-0788. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703)-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-2351.


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D.G.

November 26, 2002

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

A handwritten signature in black ink, appearing to read "Cynthia H. Kelly", written in a cursive style.